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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GOLINKOFF, JORDAN	
ART UNIT	**PAPER NUMBER**
2174	8

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/877,729	WAKEFIELD, FRANZ	
	Examiner	Art Unit	
	Jordan S Golinkoff	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. New corrected drawings are required in this application because of numerous barely legible handwritten sections as well as mistakes and corrections made over mistakes in the drawings. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

2. The drawings are objected to because:

- In figure 2B, elements 230 and 236 the word "hilites" should be changed to "highlights".
- In Figure 3, applicant has a notes section. The explanation or qualification of drawings should be done in the Description of Drawings section or the Detailed Description of the Invention section of the application. The notes included in the figure 3 should be removed and placed in an appropriate location.
- In Figure 2B, the line that extends to the B within a circle has no arrows. This line needs to have an arrow to indicate the direction that the algorithm should go during its processing.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

Page 6, line 5 – "instant" should be changed to "instant invention".

Appropriate correction is required.

Claim Objections

4. Claims 8 and 10 are objected to because of the following informalities:

- Claim 8 does not state the claim it depends on and it is not independent. Examiner will assume that claim 8 is dependent on claim 1 as it makes reference to activating a hot spot.
- Claim 6 – "at lease" should be changed to "at least".

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 states "a means for communicating a website user with a digital media file having at least one said hot spot." It is unclear what type of communication the applicant is claiming and in what direction the communication should occur. The examiner will interpret it to mean "a means for communicating a website to a user with...".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 5, 6, 8, 11-15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Horowitz et al. ("Horowitz," US006122647A).

As per independent claim 1, Horowitz teaches a multifunctional hot spot apparatus comprising a set of processed or readable instructions storable on a retaining medium (column 5, lines 25-33); at least one hot spot defined by any communication with said instructions, and having a means for performing at least one of a plurality of predetermined functions, to said hot spots being accessible from a globally accessible network (column 7, lines 27-32); means, defined by said instructions, for selecting and activating at least one of said predetermined functions (column 7, lines 27-32).

As per claim 2, which is dependent on claim 1, Horowitz teaches a means for identifying said hot spots (column 7, lines 19-22).

As per claim 5, which is dependent on claim 1, Horowitz teaches a means for linking to at least one predetermine URL address when said hot spot is activated (column 6, lines 21-27).

As per claim 6, which is dependent on claim 1, Horowitz teaches a means for storing and retrieving digital media, said digital media having at least one said hot spot defined therein (column 6, lines 12-18).

As per claim 8, which is dependent on claim 1, Horowitz teaches a means for accessing and activating digital media when said hot spot is activated (column 6, lines 12-18).

As per claim 11, which is dependent on claim 1, Horowitz teaches that hot spots reside on and are accessible from a digital video file (column 6, lines 12-18 and column 6, lines 35-41).

As per claim 12, which is dependent on claim 1, Horowitz teaches that hot spot resides in and is accessible from an audio digital file (column 6, lines 12-18 and column 6, lines 35-41).

As per claim 13, which is dependent on claim 1, Horowitz teaches that hot spot resides in and is accessible from a digital media file (column 6, lines 12-18 and column 6, lines 35-41).

As per claim 14, which is dependent on claim 1, Horowitz teaches that the means for selecting and activating comprises: a menu of identifiers in communication with said functions for identifying and providing access to said functions (column 7, lines 49-53); said identifiers each corresponding to and being in communication with at least one of said predetermined functions, said identifiers having a means for activating a function when a corresponding identifier is activated (column 7, lines 44-53).

As per claim 15, which is dependent on claim 1, Horowitz teaches at least one globally accessible address that is accessible through a globally accessible network when said corresponding identifier is selected (column 6, lines 21-27).

As per claim 19, which is dependent on claim 1, Horowitz teaches a means for adding at least one additional function to a predetermined hot spot (column 7, lines 40-44).

As per independent claim 20, Horowitz teaches a software apparatus for use on a globally accessible website, comprising:

A set of processed readable instructions stored on a tangible medium for creating and controlling at least one pre-identified hot spot, said hot spot having a plurality of predetermined functions (column 7, lines 27-32); said functions dictating the action taken by said hot spots when activated, said functions having means for accessing predetermined locations that are accessible from a globally accessible network (column 6, lines 21-27); means for selecting and activating at least one function from said plurality of functions based on predetermined parameters, at least one of said predetermined parameters comprising a user originated input that selects and activates at least one function from said plurality of functions when said hot spot is activated (column 7, lines 44-53).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. ("Horowitz," US006122647A) in further view of Hunt et al. ("Hunt," US005893091A).

As per claim 3, which is dependent on claim 1, the teachings of Horowitz in regards to claim 1 have been discussed above. Horowitz does not disclose a means for identifying items available on a website for purchase.

Hunt teaches a means for identifying items available on a website for purchase (column 6, lines 31-38). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Horowitz with a means to identify items available for purchase on a website, as taught by Hunt, with the motivation to alert the user to a sale item and to allow the user to find out more about a product (column 6, lines 37-38).

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. ("Horowitz," US006122647A) in further view of Ausubel (US006021398A).

As per claim 4, which is dependent on claim 1, the teachings of Horowitz in regards to claim 1 have been discussed above. Horowitz does not disclose a means for conducting an auction and receiving bids for the purchase of identified items.

Ausubel teaches a means for conducting an auction and receiving bids for the purchase of identified items (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Horowitz to include a means to conduct an auction and receive bids, as taught by Ausubel, with the motivation to allow users to engage in auction activity more efficiently (column 5, lines 26-30).

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. ("Horowitz," US006122647A) in further view of Dekelbaum et al. ("Dekelbaum," US005838682A).

As per claim 7, which is dependent on claim 1, the teachings of Horowitz in regards to claim 1 have been discussed above. Horowitz does not disclose a means for calling a predetermined phone number when said hot spot is activated.

Dekelbaum teaches a means for calling a predetermined phone number when said hot spot is activated (column 12, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Horowitz with a means to

call a phone number when a hotspot (*i.e. hyperlink*) is activated, as taught by Dekelbaum, with the motivation to automatically initiate connectivity with an individual over a telephone network in order to receive help from or communicate with other parties (column 5, lines 10-14).

13. Claims 9, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. ("Horowitz," US006122647A) in further view of Efrat et al. ("Efrat,"US006570587B1).

As per claim 9, which is dependent on claim 1, the teachings of Horowitz in regards to claim 1 have been discussed above. Horowitz does not disclose a means for communicating a website to a user with a digital media file having at least one said hot spot.

Efrat teaches a means for communicating a website to a user with a digital media file having at least one said hot spot (column 5, lines 25-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Horowitz with a means to communicate a website to a user, as taught by Efrat, with the motivation to allow users to activate hotspots that communicate websites in digital media (column 2, lines 15-18).

As per claim 16, which is dependent on claim 1, the teachings of Horowitz in regards to claim 1 have been discussed above. Horowitz does not disclose at least one predetermined parameter that activates a corresponding function from said plurality of functions when said parameter is satisfied.

Efrat teaches that at least one predetermined parameter that activates a corresponding function from said plurality of functions when said parameter is satisfied (column 27, lines 12-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Horowitz with a means to activate a plurality of functions when

a parameter is met, as taught by Efrat, with the motivation to allow the application to initiate certain actions without user input (column 26, lines 12-14).

As per claim 17, which is dependent on claim 16, Efrat teaches that at least one predetermined parameter comprises the reaching of a predetermined segment of a digital media file (column 27, lines 33-45).

As per claim 18, which is dependent on claim 17, Efrat teaches a means for overwriting said parameter when a user selects at least one of said plurality of predetermined functions (column 26, lines 12-15, *user can activate hotspots prior to a programmatic actuation and thereby effectively overwrite the programmatic action by preventing it from ever occurring*).

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. ("Horowitz," US006122647A) in further view of Krasle (US006029135A).

As per claim 10, which is dependent on claim 1, the teachings of Horowitz in regards to claim 1 have been discussed above. Horowitz does not disclose a voice recognition means for activating at least one of said predetermined functions based on the sound of the user's voice.

Krasle teaches a voice recognition means for activating at least one of said predetermined functions based on the sound of the user's voice (column 2, lines 27-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Horowitz with a means to activate a function based on a user's voice, as taught by Krasle, with the motivation to allow a user to engage in hands-free navigation of a linked document (columns 1-2, lines 66-2).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan S Golinkoff whose telephone number is 703-305-8771. The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Jordan Golinkoff
Patent Examiner
January 15, 2004

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